

DAC 15 #7



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Dan A. Steinberg, David W. Sherrer, Mindaugas F. Daurtartas and Robert C. Schinazi

EXAMINER: Unknown GROUP: 2874

SERIAL NO.: 10/037,971 CONFIRMATION NO: 7497

FILED: October 24, 2001

FOR: *Fiber Array with V-Groove Chip and Mount*

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: BOX DAC, Assistant Commissioner for Patents, Washington, DC 20231 on:

By: *Mavis Eliseev*

*November 18, 2002*  
Date

BOX DAC  
Assistant Commissioner for Patents  
Washington, DC 20231

REQUEST FOR RECONSIDERATION OF  
PETITION UNDER 37 CFR 1.47 (a)

Sir:

This is in response to the Decision Refusing Status Under 37 CFR 1.47(a) (a copy of which is enclosed), dated September 16, 2002.

Enclosed are two (2) executed Declarations (nine pages) in compliance with 35 U.S.C. §§ 115 and 116.

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Please charge any required fee for this response to Deposit Account No. 50-0369.

Respectfully submitted,

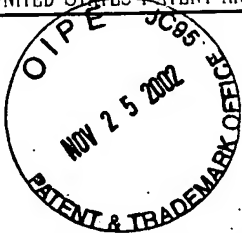
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Dated: November 18, 2002



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Paper No. 6

MARIA M. ELLSEEVA, ESQ.  
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In re Application of :  
Steinberg, Sherrer, Duartartas, and :  
Schinazi : DECISION REFUSING STATUS  
Application No. 10/037,971 : UNDER 37 CFR 1.47(a)  
Filed: 24 October, 2001 :  
Atty Docket No. ACT141P (11671003) :

This is in response to the petition filed under 37 CFR 1.47(a) on 26 August, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.  
**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**  
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified issue application was filed on 24 October, 2001, without an executed oath or declaration. Accordingly, on 19 March, 2002, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration and a surcharge for its late filing. In response, on 26 August, 2002 (certificate of mailing date 19 August, 2002), petitioners filed a three (3) month extension of time, accompanied by the present petition and authorization to charge the petition fee and late-filing surcharge and a declaration naming Dan A. Steinberg, David W.

Sherrer, Mindaugas F. Duartatas, and Robert G. Schinazi as joint inventors and signed by joint inventors Sherrer and Duartatas on behalf of themselves and joint inventors Steinberg and Schinazi.

Petitioners state that joint inventor Sherrer asked joint inventor Steinberg to sign the declaration, but joint inventor Steinberg refused to sign the declaration. Additionally, petitioners state that joint inventor Schinazi cannot be reached.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1). Petitioners have not shown proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) was sent or given to the non-signing inventors for review.<sup>1</sup> Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign can be alleged, petitioners must provide proof that the inventors have refused to sign the declaration.<sup>2</sup> If there is a written refusal, petitioners should submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

If application papers sent to one or more of the inventors at

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<sup>1</sup>MPEP 409.03(d).

<sup>2</sup>Id.

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OFFICE OF PETITIONS

Application No. 10/037,971

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their last known addresses are returned as undeliverable, petitioners may show proof that diligent efforts have been made to locate the non-signing inventor(s) by providing a copy of an envelope showing that a letter sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Additionally, if an inventor(s) cannot be reached at his or her last known address, petitioners must provide details, in an affidavit or declaration of facts by a person with first hand knowledge of the details, of the efforts, such as Internet, e-mail, or telephone directory searches, which have been undertaken to locate that inventor, send or give a copy of the application papers to him or her, and request that he or she sign and return the declaration. If repeated attempts to contact an inventor(s) by telephone, mail, and e-mail, are unsuccessful, petitioners will have established that an inventor(s) cannot be found despite diligent efforts.

It is also noted that if a more recent last known address is found for joint inventor Schinazi, that address should be provided with any renewed petition.

Counsel's deposit account, No. 50-0369, has been charged the \$130.00 fee for consideration of the petition under 37 CFR 1.47(a).

The correspondence address has been changed as indicated in the declaration and power of attorney filed on 26 August, 2002.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy